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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEFAN LIESCHE, ANDREAS NAUERZ, and JÜRGEN SCHAECK

Appeal 2016-004145
Application 12/440,893
Technology Center 2400

Before ALLEN R. MacDONALD, AMBER L. HAGY, and PHILLIP A. BENNETT, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claims

Claims 1 and 10 under appeal read as follows (emphases added):

1. Computer system for dynamic integration of web portal content elements into a web portal application reflected by a memory tree in a memory of a portal server presenting the web portal application to a user, the memory tree including an extension node, the computer system comprising:

a context observer module configured to, responsive to an activation event associated with the extension node, ***dynamically detect*** context data associated with the user and ***provide*** the detected context data to a context launch transformation module;

the ***context launch transformation module*** including transformation logic and ***configured to***, responsive to the activation event, ***execute*** the transformation logic depending on the detected context data ***to automatically and dynamically generate*** a subtree of dynamic content nodes representing content elements not previously in the memory tree, wherein content nodes represent web pages and/or portlets;

a dynamic assembly module configured to associate transformation logic to the extension node, wherein said dynamic assembly module is ***further configured to provide*** the subtree of dynamic content nodes to an aggregation module;

the ***aggregation module configured to insert*** the subtree of dynamic content nodes below the extension node in the memory tree, wherein the aggregation module is ***configured to integrate*** content nodes representing content elements into the memory tree; and

a portal server module configured to provide the web portal application to the user according to the memory tree and wherein the context data is detected by the context observer module while providing the web portal application to the user;

wherein the context observer module, context launch transformation module, dynamic assembly module, aggregation module, and portal server module are all executed by a hardware platform of the computer system, the hardware platform including at least one processor.

10. A method of dynamically integrating content elements into a web portal application provided to a user by a portal server, comprising:

associating an activation event to a transformation logic at the portal server, by a ***dynamic assembly module***;

while providing the web portal application:

receiving an activation event at a ***context launch transformation module*** associated with the web portal application at the portal server and responsive to a user action in the web portal application;

detecting context data by a ***context observer module***, the context data indicating a user context;

providing the context data to the context launch transformation module, by the context observer module responsive to detecting the context data;

executing the transformation logic depending on the context data, responsive to receiving the activation event while providing the web portal application, while automatically and

dynamically creating a subtree of dynamic content nodes representing content not previously in a navigation topology of the web portal application, by the context launch transformation module;

providing the subtree of dynamic content nodes to ***an aggregation module***, by the dynamic assembly module responsive to executing the transformation logic; and

> inserting the subtree of dynamic content nodes into a memory tree of content nodes representing content elements in the navigation topology of the web portal application, by the aggregation module.

Rejection on Appeal

1. The Examiner rejected claims 1–20 as being unpatentable under 35 U.S.C. § 102(b) as anticipated by and Bales et al. (US 2004/0230679 A1; publ. Nov. 18, 2004).[1]

Appellants' Contentions[2]

1. Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) because:

> Claims are to be interpreted in their broadest reasonable interpretation ***in light of the specification***. In the rejection, the Examiner admits that the Office is relying on meanings beyond the broadest reasonably meaning of the claimed terms in light of the specification. Specifically, the Examiner notes on page 2 of the Action that the relied upon interpretation of terms such as "action event, context data, memory tree, etc.) have been interpreted using a meaning that "extends well beyond the scope of the specification". The Examiner further states that that the Office is required to interpret meanings of the claimed terms broader than the specification. (page 2 of the Action).
>
> This statement is inaccurate. The USPTO is required to interpret claims in their broadest reasonable manner in light of the specification. The Action indicates that something beyond this was utilized and required. The undersigned would like the Board to comment. On its face, this is an application of an improper standard, as the meaning of terms must be interpreted

[1] Separate patentability is not argued for claims 2–20. Therefore, except for our ultimate decision, the rejection of claims 2–20, is not discussed further herein.

[2] These contentions are determinative as to the rejection of claim 1. Therefore, Appellants' other contentions are not discussed herein.

> in light of the specification, which the Office is explicitly violating. On this basis, the rejections are in error and should be withdrawn.

App. Br. 13.

2. Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) because:

> Bales, which was cited as anticipating the above claim, lacks explicit or inherent teachings for a memory tree. Lacks explicit or inherent teachings for generating a subtree. Lacks explicit or inherent teachings for the memory tree including an extension node. Lacks explicit or inherent teachings for a memory tree being in the memory of a portal server. Lacks explicit or inherent teachings of a detecting context data (that generates the substree [sic] of information not previously in the memory tree) while providing the web portal application to the user. Rejections of claim 1 are in error as a result.

App. Br. 17.

> Turning to the claims, Bales is completely silent regarding a "memory tree in a memory of a portal server." No teachings for this material claimed limitation are present. The action attempts to equate GUI elements of a client-side browser "content hierarchy, components tree, portal hierarchy, etc.),["] which are inconsistent with the claimed limitations. That is, the claims require the memory tree to be a memory of a portal server, which is not present in Bales.

App. Br. 18.

> The claims limitations of claim 1 require detected context data to automatically and dynamically generate a subtree of dynamic content nodes represent content elements not in the memory tree (of the portal server. No subtree is generated in Bales that is equivalent (our claims are for a data structure of a portal server, not for a GUI presentation on a client).

App. Br. 19.

Issues on Appeal

Did the Examiner err in rejecting claim 1 as being anticipated by Bales?

ANALYSIS

We have reviewed the Examiner's rejection in light of Appellants' arguments (Appeal Brief) that the Examiner has erred. Although we disagree with most of Appellants' contentions (e.g., contention 1, discussed *infra*), we agree with Appellants' contention 2 for reasons discussed *infra*.

As to Appellants' above contention 1, we disagree. First, at best, Appellants' argument constructs a straw man statement, and then proceeds to knock down that straw man. Appellants argue a statement ("the Examiner admits that the Office is relying on meanings beyond the broadest reasonably [sic] meaning of the claimed terms in light of the specification" App. Br. 13) the Examiner never made. This form of argument is unavailing to show Examiner error.

Second, Appellants' argument rests on an assumption that a claim interpretation is automatically unreasonable if it is not limited to the embodiments of the specification. We find no support in the law for reading such a limitation into the claims from the embodiments in the Specification. To the contrary, our reviewing court has stated "although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

As to Appellants' above contention 2, we agree. We conclude the Examiner erred in finding Bales discloses using "detected context data to automatically and dynamically generate a subtree of dynamic content nodes represent content elements not in the memory tree." Final Act. 5.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claims 1–20 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Federal Circuit has established use of the term "means" is central to the analysis of whether a claim limitation should be interpreted in accordance with 35 U.S.C. § 112, sixth paragraph.[3] Use of the word "means" creates a rebuttable presumption that the inventor intended to invoke 35 U.S.C. § 112, sixth paragraph, whereas failure to use the words "means for" creates a rebuttable presumption that the inventor did not intend the respective claim limitations to be governed by 35 U.S.C. § 112, sixth paragraph. *Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 703–04 (Fed. Cir. 1998). However, this presumption against its invocation can be overcome and 35 U.S.C. § 112, sixth paragraph, applied, if the "claim term fails to 'recite[] sufficiently definite structure' or else

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[3] 35 U.S.C. § 112, sixth paragraph reads

> An element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of structure, material, or acts in support thereof*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

(Emphasis added).

recites 'function without reciting sufficient structure for performing that function.'" *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc) (quoting *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000)).

First, we determine claim 1 does not recite the terms "means for" in each element; rather, the "context launch transformation module" limitation recites an element "configured to" achieve a result based on performing a series of functions. More specifically, the limitation recites a (emphases added): "***context launch transformation module*** including transformation logic and *configured to* . . . execute the transformation logic . . . to automatically and dynamically generate a subtree of dynamic content nodes" (claim 1). Thus, we look to determine if the presumption against invocation of 35 U.S.C. § 112, sixth paragraph, has been overcome. Within claim 1, this "context launch transformation module" limitation fails to recite sufficiently definite structure if the limitation recites functions without reciting sufficient structure for performing the functions (*Williamson*, 792 F.3d at 1348 (citation omitted)). In this case, the "context launch transformation module" purports to be the structure performing the recited functions. We must determine, therefore, "whether the term [context launch transformation module] is one that is understood to describe structure, as opposed to a term that is simply a nonce word or a verbal construct that is not recognized as the name of structure and is simply a substitute for the term 'means for.'" *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (Fed. Cir. 2004).

We have looked to both general and subject matter specific dictionaries[4] and we find no evidence that the term "context launch transformation module" has achieved recognition as a term denoting structure. Similarly, our review of the record and search of the prior art finds no evidence that this term has achieved recognition as denoting structure. Therefore, based upon our consultation of dictionaries, a review of the record before us, and a search of the prior art patents in this field, we conclude that the term "context launch transformation module" is not an art-recognized structure to perform the claimed functions, and claim 1 does not recite any other structure that would perform these claimed functions.

Moreover, Appellants have not persuaded us the term "context launch transformation module" identifies or connotes a definite structure. More specifically, we are not persuaded the term "context launch transformation module" is used in "common parlance or by persons of skill in the pertinent art to designate structure," such that it connotes sufficient structure to avoid the application of 35 U.S.C. § 112, sixth paragraph. *Lighting World*, 382 F.3d at 1359, *overruled on other grounds by Williamson*, 792 F.3d at 1348–49. Accordingly, we determine the "context launch transformation module" limitation invokes the application of 35 U.S.C. § 112, sixth paragraph, because the limitation fails to describe sufficient structure and instead, recites an abstract element "configured to" (i.e., "for") causing actions.

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[4] MICROSOFT COMPUTER DICTIONARY (5th ed. 2002) (Microsoft Press); Martin H. Weik, 2 COMPUTER SCIENCE AND COMMUNICATIONS DICTIONARY (2000); THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed. 2006).

Advanced Ground Info. Sys., Inc. v. Life360, Inc., 830 F.3d 1341, 1347 (Fed. Cir. 2016).

Second, as we have determined the recited "context launch transformation module" limitation invokes 35 U.S.C. § 112, sixth paragraph, we next "construe the disputed claim term by identifying the corresponding structure, material, or acts described in the specification to which the claim term will be limited." *Robert Bosch, LLC v. Snap-On, Inc.*, 769 F.3d 1094, 1097 (Fed. Cir. 2014) (internal quotation marks and citation omitted). If Appellants' Specification fails to set forth adequate disclosure of the structure corresponding to the claimed function, Appellants will have "failed to particularly point out and distinctly claim the invention," thereby rendering the claim indefinite. *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1382 (Fed. Cir. 2009) (internal quotation marks and citation omitted).

Thus, for the "context launch transformation module" limitation, we determine if Appellants' Specification provides sufficient disclosure. Appellants assert the recited "context launch transformation module" is supported by paragraph 37 of Appellants' Specification (App. Br. 7 (Summary of Claimed Subject Matter)). Further, Appellants' Specification at paragraph 38 indicates:

> When executing the transformation logic in step 230, context launch transformation module 140 generates or manipulates a subtree of dynamic content nodes (submodel) that describes a set of web pages and/or portlets. Dynamic assembly module 120 then provides the newly created or updated subtree of dynamic content nodes to aggregation module 110 which in turn inserts the updated or newly created subtree of dynamic content nodes into the memory tree.

Although Appellants state paragraph 37 of their Specification shows the recited "context launch transformation module" (App. Br. 7), we are not persuaded sufficient structure is disclosed by paragraph 37 alone or by paragraphs 37 and 38 combined. Instead, we determine the claim limitation is a computer-implemented claim limitation. For a computer-implemented claim limitation interpreted under 35 U.S.C. § 112, sixth paragraph, the corresponding structure must include the algorithm needed to transform the general purpose computer or processor disclosed in the specification into the special purpose computer programmed to perform the disclosed algorithm. *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Techs., Inc.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008 ("[T]his court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor."); *see also Function Media, L.L.C. v. Google, Inc.*, 708 F.3d 1310, 1318 (Fed. Cir. 2013). An algorithm is defined, for example, as "a finite sequence of steps for solving a logical or mathematical problem or performing a task." MICROSOFT COMPUTER DICTIONARY 23 (5th ed. 2002) (*see also Merriam-Webster's Collegiate Dictionary* 30 (11th ed. 2007) defining algorithm as "a step-by-step procedure for solving a problem or accomplishing some end esp. by a computer"). An applicant may express the algorithm in any understandable terms including as a mathematical formula, in prose, in a flow chart, or "in any other manner that provides sufficient structure." *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008).

Because we conclude the "context launch transformation module" limitation recites a computer-implemented function, we look to Appellants'

Specification for an algorithm for performing the functions recited in the limitation. An indefiniteness rejection under § 112, second paragraph, is appropriate if the specification discloses no corresponding algorithm associated with a computer or processor. *Aristocrat*, 521 F.3d at 1337–38. Here, our review of Appellants' Specification finds no such algorithm, part of a general purpose computer, capable of performing the claimed functions of the "context launch transformation module."

Accordingly, we conclude the "context launch transformation module" claim limitation invokes 35 U.S.C. § 112, sixth paragraph, and claim 1 is indefinite under 35 U.S.C. § 112, second paragraph for lacking sufficient structure in the Specification.

As to Appellants' claim 10 (method), a potential "step plus function" limitation must be independently reviewed in order to determine if the step is subject to the requirements of section 112, sixth paragraph. *O.I. Corp. v. Tekmar Co. Inc.*, 115 F.3d 1576, 1583 (Fed. Cir. 1997). We do not engage in that analysis herein. Rather, we note that unlike the claims in *O.I. Corp.*, Appellants' method claim 10 explicitly recites the "context launch transformation module" (which we have determined invokes § 112, sixth paragraph) as the "means" for performing the recited functions of the method step ("by the context launch transformation module" at Appeal Brief page 28, line 18). Although unusual, nothing in the statute precludes Appellants from drafting a method claim that invokes § 112, sixth paragraph, using a "means plus function" in order to further limit the step being performed (regardless of whether that step itself further invokes § 112, sixth paragraph, as to a "step plus function" limitation or does not). We

have concluded the "context launch transformation module" is not structure in and of itself under 35 U.S.C. § 112, sixth paragraph, and claim 1 is indefinite under 35 U.S.C. § 112, second paragraph. Similarly we conclude claim 10 is indefinite as to the "context launch transformation module" claim limitation.

As to Appellants' claim 16 (article of manufacture in the form of a non-transitory computer readable medium), it also recites "context launch transformation module" as the "means" for performing recited functions ("by the context launch transformation module" at Appeal Brief page 30, line 4). We reach the same result as with claim 10, for the same reasons.[5]

As to Appellants' dependent claims 2–9, 11–15, and 17–20, by their dependency they incorporate the indefiniteness of their independent claims.

37 C.F.R. § 41.50(b)

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to

[5] In claim 16, at line 7, we treat the word "the" as –a– because the claim lacks prior antecedent basis for "the context launch transformation module."

> the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under §41.52 by the Board upon the same record. . . .

CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claims 1–20 as being anticipated by Bales under 35 U.S.C. § 102(b).

(2) We reject claims 1–20 under 35 U.S.C. § 112, second paragraph.

(3) Claims 1–20 are not patentable.

DECISION

The Examiner's rejection of claims 1–20 is reversed.

Claims 1–20 are newly rejected.[6]

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

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[6] As we have shown that all the claims are unpatentable, we do not repeatedly reject Appellants' claims 1–20 under 35 U.S.C. § 112, second paragraph, as being indefinite. However, should there be further prosecution of these claims; we recommend each of Appellants' claimed "module" terms be reviewed as to whether § 112, sixth paragraph, is invoked, and if yes, whether the term is indefinite. Further, as to each "module" term, a "*Wands*" analysis to determine enablement is also recommended.